

AMENDMENTS TO THE DRAWINGS

Please delete sheets 5-12 of the drawings.

REMARKS

At the time of the Office Action dated June 14, 2007, claims 1-13 were pending and rejected in this application.

On pages 2 and 3 of the Office Action, the Examiner objected to the drawings "because Figs. 1-3B appear to have been submitted in triplicate." By amendment, Applicants have requested that sheets 5-12 be cancelled. Sheets 5-12 correspond to the second and third copies of the drawings.

On page 3 of the Office Action, the Examiner objected to the drawings and the specification regarding the spelling of the word hysteresis. In response, Applicants note that both the specification and claims 6 and 11 have been amended to address this issue.

On page 3 of the Office Action, the Examiner objected to claims 1 and 2. Since claims 1 and 2 have been cancelled, this rejection is moot.

On page 3 of the Office Action, the Examiner objected to claims 4 and 7 in which the Examiner asserted that the phrase "does not comports" appears to be a typographical error. In response, Applicants note that claims 4 and 7 have been amended to replace the phrase "does not comports" with "does not comport."

CLAIMS 1-13 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On page 4 of the Office Action, the Examiner asserted that claims 1-13 are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

On page 4 of the Office Action, the Examiner asserted the following:

The term "autonomically" in claims 1 and 3 is used by the claim to mean "without the manual intervention of a human operator", while the accepted meaning is "in a manner related to the portion of the vertebrate nervous system that governs involuntary actions." The term is indefinite because the specification does not clearly redefine the term.

Applicants respectfully disagree with the Examiner's conclusion. In this regard, Applicants note that a similar issue was addressed before the Examiner in U.S. Application No. 10/635,586. Specifically, the following arguments were presented. Specifically, the Examiner has failed to establish a prima facie case of indefiniteness under the second paragraph of 35 U.S.C. § 112. M.P.E.P. § 2173.02 states the following:

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. (emphasis added).

As stated in Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings,¹ "[o]nly when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." Applicants' position is that one having ordinary skill in the art would have no difficulty understanding the scope of claims 1-13, particularly when reasonably interpreted in light of the written description of the specification.²

¹ 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

² In re Okuzawa, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

In this regard, Applicants note that a search of Google using the phrase "autonomic computer" in quotes (i.e., "autonomic" must be found immediately preceding the term "computer") yields 18,900 hits, and the term "autonomic" used in conjunction with "computer" yields 1.61 million hits.

Referring to the Merriam-Webster Online Dictionary, a definition of "autonomic"³ is "acting or occurring involuntarily." Moreover, a definition of "autonomy"⁴ is "the quality of being self-governing." Still further, a definition of "autonomous"⁵ is "undertaken or carried on without outside control." Thus, Applicants respectfully submit that one having ordinary skill in the computer arts would readily recognize that an "autonomic system" is one that can operate "without the manual intervention of a human operator." Therefore, Applicants respectfully submit that one having ordinary skill in the art would have no difficulty understanding the scope of the term "autonomic," particularly when reasonably interpreted in light of the written description of the specification.

On page 5 of the Office Action, the Examiner rejected claim 2. However, since claim 2 has been cancelled, this rejection is moot.

On pages 5-6 of the Office Action, the Examiner rejected claims 2, 6, and 11 based upon the phrases "to prevent a hysteresis condition" and "to avoid a hysteresis condition." In response, Applicants note that claims 6 and 11 no longer recite these phrases.

³ <http://www.m-w.com/dictionary/autonomic>.

⁴ <http://www.m-w.com/dictionary/autonomy>.

⁵ <http://www.m-w.com/dictionary/autonomous>.

On page 6 of the Office Action, the Examiner specifically identified the phrase "responsive to a further determination that said outcome from said course of action does not comport with said predicted outcome." As already identified by the Examiner, the claims previously recite "further determining whether an outcome from said course of action comports with a predicted outcome." Thus, the first phrase (i.e., "further determining") refers to the step being performed, whereas the second phrase (i.e., "responsive to a further determination") refers to the result (i.e., the determination) of the previously referred to step. Therefore, both claims 4 and 9 recite performing the determining step, and then upon a "determination that said outcome from said course of action does not comport with said predicted outcome," then the step of "changing a point count ..." is performed.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 4-13 under the second paragraph of 35 U.S.C. § 112 has been overcome and, hence, Applicants respectfully solicit withdrawal thereof.

Thus, for the reasons stated above, Applicants submit that the imposed rejection of claims 4-13 under the second paragraph of 35 U.S.C. § 112 has been overcome and, hence, Applicants respectfully solicit withdrawal thereof.

CLAIMS 1-3 ARE REJECTED UNDER 35 U.S.C. § 101

Although Applicants disagree with the Examiner's rejection, Applicants note that claims 1-3 have been cancelled. Thus, the Examiner's rejection as to these claims is moot.

**CLAIMS 1 AND 3 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED
UPON HERZ ET AL., U.S. PATENT NO. 5,754,939**

Although Applicants disagree with the Examiner's rejection, Applicants note that claims 1 and 3 have been cancelled. Thus, the Examiner's rejection as to these claims is moot.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

Application No.: 10/635,878

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: September 13, 2007

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320